

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated January 3, 2006 (hereinafter Office Action) have been considered. Claims 1-30 remain pending in the application. Claims 1-21 are rejected. Claims 22-30 are listed as subject to a restriction requirement. Claims 14, 19, and 21 have been amended. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-10, 14, 16-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0096628 to Bar-On.

Applicant believes the statement in the Office Action that claims 22-26 stand rejected is a typographical error. It appears from the Office Action that the restriction requirement was made final and the claims of Group II (claims 22-30) are presently withdrawn from prosecution. Applicant reserves the right to address the rejections of claims 22-26 in the event that these claims are not withdrawn from prosecution.

Applicant respectfully disagrees with the Examiner's characterization of Bar-On and the contention that Bar-On anticipates claims 1-10, 14, 16-21. Applicant respectfully asserts that several features recited in the rejected claims are not disclosed in Bar-On.

To anticipate a claim, the asserted reference must clearly and unequivocally disclose every element of the claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. All claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

The present invention, as recited, for example, in independent claims 1, 20, 14, 16, 19, and 21, is directed to methods, systems and devices for facilitating the formation of groups of mobile terminal users. Independent claims 1, 10, and 16, and independent claims 14, 19, and 21, as amended, include in some form, the element of a capability criterion for determining the mobile terminal groups.

Bar-On does not teach or suggest at least the use of a capability criterion as recited in Applicant's independent claims 1, 10, 14, 16, 19, and 21. Figures 1 and 2 of Bar-On do

not show the capability criterion as indicated in the Office Action. Figure 1 is a schematic illustration of a communication system. There is no mention of the use of a capability criterion used in the formation of groups in Figure 1 or the associated text. Figure 2 is a diagram of the GUI which may be used on the mobile terminals of the system of illustrated in Figure 1. The GUI interface includes check boxes that are used in selection of service areas (locations) to be included in a group call. Bar-On only teaches the selection of service areas for group calls. There is no teaching or suggestion in Bar-On that a terminal capability criterion is used in the formation of a group of mobile terminals as is recited in Applicants independent claims 1, 10, 14, 16, 19, and 21.

For at least these reasons, the Bar-On reference fails to support the 35 U.S.C. §102 rejections of Applicant's independent claims 1, 10, 14, 16, 19, and 21 and these claims are patentable over Bar-On.

Dependent claims 2-9, 17, 18, and 20 which are dependent from independent Claims 1, 16, or 19, respectively, were also rejected under 35 U.S.C. §102(e) as being unpatentable over Bar-On. While Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent Claims 1, 10, 14, 16, 19, and 21. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 2-9, 17, 18, and 20 are also in condition for allowance. For example, specifically with regard to the rejection of dependent claims 4 and 5, Applicant respectfully asserts that Bar-On Figures 1 and 2 clearly do not teach or suggest the use of a datum point or landmark for defining a circumference relative to the datum point or landmark to define the group session area. There is no landmark or datum point shown in Figures 1 or 2 and the associated text does not mention forming a group based on a datum point or landmark. Bar-On states that the group call is set up in selected service areas. (see page 2, paragraphs 0019-0021).

Claims 11-13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bar-On in view of U.S. Publication No. 2005/0221812 to Gailey.

To support a *prima facie* case of obviousness, the combination of references must teach or suggest each claim limitation. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Also, there must be a reasonable expectation of success.

The rejections of claims 11-13 rely on Bar-On to teach every claim limitation of claim independent 10 and rely on Gailey to teach the location server and application server. The rejection of claim 15 relies on Bar-On to teach every limitation of independent claim 14 and rely on Gailey to teach the transceiver configured to exchange the group criteria definition with the application server.

As discussed above, Bar-On does not teach or suggest all the elements of claim 10 or claim 14.

In addition, Gailey does not teach or suggest a location server adapted to maintain location information associated with the mobile terminals as recited in claim 11 or an application server as recited in claim 12. The location-based application (element 28 of Figure 1) mentioned in Gailey is a system that includes profile, business, and usage data files. With respect to the rejection of claim 11, for example, none of the data files described in Gailey relate to location information associated with the plurality of mobile terminals. As a further example, with respect to claims 12 and 13, the application server is not configured to receive or provide group member criteria.

In addition to the deficiencies of the asserted combination to teach or suggest all of the claim elements, there would be no motivation to combine the references as proposed, and there is no indication that any such combination would successfully yield Applicant's invention as recited in the rejected claims. The Office Action does not provide any evidence that a motivation to combine these references exists, or that any such combination would successfully yield Applicant's claimed invention.

For at least these reasons, the combination of Bar-On and Gailey fails to support a *prima facie* case of obviousness, and claims 11-13 and 15 are patentable over the asserted combination.

It is to be understood that Applicant does not acquiesce to Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to the Examiner's statements or conclusions concerning what elements are inherent or would have been obvious to one of ordinary skill in the art and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.075PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her to discuss any issues related to this case.

Respectfully submitted,

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